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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,498	05/15/2001	John E. Sims	0317-US	8629

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IMMUNEX CORPORATION
LAW DEPARTMENT
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SEATTLE, WA 98101

EXAMINER

HAMUD, FOZIA M

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 01/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,498

Applicant(s)

Sims et al.

Examiner

Fozia Hamud

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 15, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-43 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 21-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. This application is a 371 of PCT/US99/18771. For applications filed under 371, PCT rules for lack of unity apply.
2. This application contains inventions or groups of inventions which are not so linked as to form a single inventive concept. Under PCT Rule 13.1 the following combinations of claims of different categories are permissible and restriction to one of the following combinations is required:

Applicants are advised that claims 21, 26, 29, 32, 38 and 39 are improper Markush claims because the multiple elements recited therein, nucleic acids encoding the polypeptides of SEQ ID Nos:6, 8 and 13 and the polynucleotides of SEQ ID Nos:5, 7 and 12, do not share a common technical feature which is based on a common property or special technical feature not found in the prior art. Because each encoded polypeptide sequence and each specific polynucleotide sequence (SEQ ID Nos: 5, 7, 12) is different, independent and distinct chemical compounds lacking either a common structural property which distinguishes them as group from structurally related compounds of the prior art or which provides them with a common utility which is lacking from those prior art polypeptides or nucleic acids.

- I. Claims 21, 26, 29, 32-33 and 38-39, drawn to an isolated nucleic acid molecule, encoding the polypeptide of SEQ ID NO:6, said nucleic acid molecule comprising the nucleotide sequence set forth in SEQ ID NO:5, an expression vector comprising said

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nucleic acid, a host cell comprising said vector, a method of producing the polypeptide of SEQ ID NO:6 and the polypeptide of SEQ ID NO:6.

- II. Claims 21, 22, 24, 26-27, 29-30, drawn to an isolated nucleic acid molecule, encoding the polypeptide of SEQ ID NO:8, said nucleic acid molecule comprising the nucleotide sequence set forth in SEQ ID NO:7.
- III. Claims 21, 23, 25, 26, 28, 29, 31-32 drawn to an isolated nucleic acid molecule, encoding the polypeptide of SEQ ID NO:13, said nucleic acid molecule comprising the nucleotide sequence set forth in SEQ ID NO:12.
- IV. Claims 32, 34, 36, drawn to a polypeptide encoded by the nucleic acid of SEQ ID NO:7, said polypeptide comprising amino acid residues 1-158 of SEQ ID NO:8, and soluble fragment of said polypeptide.
- V. Claims 32, 35, 37 drawn to a polypeptide encoded by the nucleic acid of SEQ ID NO:12, said polypeptide comprising amino acid residues 1-158 of SEQ ID NO:13, and soluble fragment of said polypeptide.
- VI. Claim 38-39, drawn to a method of producing the polypeptide of SEQ ID NO:8, by culturing a host cell which expresses said polypeptide.
- VII. Claim 38-39, drawn to a method of producing the polypeptide of SEQ ID NO:13, by culturing a host cell which expresses said polypeptide.
- VIII. Claim 40, 42, drawn to an antibody that binds to the polypeptide of SEQ ID NO:8.
- IX. Claim 41, 43, drawn to an antibody that binds to the polypeptide of SEQ ID NO:13.

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Pursuant to 37 C.F.R. 1.475(d), this Authority considers that the main invention in the instant application comprises the first-recited product, polynucleotide encoding the polypeptide of SEQ ID NO:6, and the first-recited method of using that product, namely in the process of producing the encoded polypeptide. Note that there is no method of making the polynucleotide. Further, pursuant to 37 C.F.R. 1.475(b)-(d), the ISA/US considers that the materially and functionally dissimilar products of groups II -V and VIII-IX and the additional methods of groups VI-VII do not correspond to the main invention. This Authority therefore considers that the several inventions do not share a special technical feature within the meaning of PCT Rule 13.2 and thus do not relate to a single general inventive concept within the meaning of PCT Rule 13.1.

3. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia Hamud whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday-Thursdays from 7:00AM to 4:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

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Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Fozia Hamud
Patent Examiner
Art Unit 1647
22 January 2002


YVONNE EYLER, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600